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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/709,774

05/27/2004

James J. Wang

25040-1155

3773

29052

7590

06/19/2007

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EXAMINER

ELKINS, GARY E

ART UNIT

PAPER NUMBER

3782

MAIL DATE

DELIVERY MODE

06/19/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/709,774

Applicant(s)

WANG, JAMES J.

Examiner

Gary E. Elkins

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-13 and 15-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8 is/are allowed.
- 6) ☒ Claim(s) 1-7, 9, 11-13 and 15-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Claims 13 and 15-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The newly recited recitation in each of claims 13, 20 and 21 that the corner posts are rectangular is new matter. The posts were never disclosed as rectangular and, as shown in the drawings, they are not rectangular since they each comprise only two sides at a corner of the container. The top of the container includes rectangular corner flaps as originally described in the specification and claimed. For the purpose of applying the prior art below with respect to claims 13 and 15-21, it is assumed that the corner flaps as opposed to corner posts are being referred to as "rectangular".

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3, 13 and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bone. Bone discloses top panel (95, 105, etc), first and second side panels 90, top panel tab 70, a first score line formed by the center tear line and second score lines between removable portions 90 and corner flaps 105 at each corner. The corner portions 105 and the portions of the

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respective side panels and end panel therebelow are considered to form corner posts insofar as claimed. Bone does not disclose a rectangular shape to the corner flaps. It would have been an obvious matter of design choice to change the form or shape of the corner flaps to a rectangular shape in Bone as a mere selection of one shape over any other. No functional distinction is seen between the shape claimed and that shown in the prior art to Bone. Design applications are available to obtain patent protection where the sole distinction between the prior art is one of shape or aesthetics. Also, no convincing argument has been made that the particular shape claimed is significant or is more than one of numerous configurations a person of ordinary skill in the art would have found obvious. See *Graham v. John Deere Co.*, 148 USPQ 459 (1967) and *In re Dailey*, 149 USPQ 47 (CCPA 1976). With respect to claim 15, Bone discloses corners with a length along the respective side and end panels which is very small as compared to the overall lengths of the side and end panels. However, Bone does not disclose a length of the corner posts along the respective side panels and the end panel of about 1 cm. It would have been an obvious matter of design choice to make the lengths of the corner posts along the respective side and end panels in Bone about 1 cm as a mere selection of one size over another. No functional distinction can be seen nor has any been asserted by Applicant with respect to the claimed size over the size(s) shown in the prior art. A mere change in the size of a component has generally been held unpatentable. See *In re Rose*, 105 USPQ 237 (CCPA 1955). It is noted that the ability to size a container to hold a given size or height of content is well within the level of skill in this art. The sizing of the corner posts is considered related to the overall size of the container which is a function of size of the desired contents one wishes to package. With respect to claims 16 and 17, Bone discloses all structure of the claimed carton except a length of the

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corner post in the side panels of about 8.3 cm and, with respect to claim 17, a length into the end panel of about 8 cm. It would have been an obvious matter of design choice to make the lengths of the corner posts in Bone within the side and end panels of about 8.3 cm and 8 cm, respectively as a mere selection of one size over another. No functional distinction can be seen nor has any been asserted by Applicant with respect to the claimed size over the size(s) shown in Bone. A mere change in the size of a component has generally been held unpatentable. See *In re Rose*, 105 USPQ 237 (CCPA 1955). It is noted that the ability to size a container to hold a given size or height of content is well within the level of skill in this art. The sizing of the corner posts is considered related to the overall size of the container which is a function of size of the desired contents one wishes to package.

4. Claims 1, 3, 13, 16, 17, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mazocky (EP '029). Mazocky discloses a top panel, side panels 4, 5, top panel tab 11, a first score line 17 extending between sides 4, 5 in the near the center of the top wall, second score lines 17 respectively extending at an angle from the side panels to the end panel and corner flaps formed by the angled score lines. With respect to claims 13 and 19, the corner flaps formed in the top wall and the sections of the side walls and end walls therebelow are considered to form corner posts insofar as claimed. With respect to claim 20, it is noted that the top enclosure or panel, the side enclosures or panels and the end enclosures or panels include multiple score lines (e.g. note sections 3a in the end panel) defining the corner posts insofar as claimed. Mazocky does not disclose a rectangular shape to the corner flaps. It would have been an obvious matter of design choice to change the form or shape of the corner flaps to a rectangular shape in Mazocky as a mere selection of one shape over any other. No functional

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distinction is seen between the shape claimed and that shown in the prior art to Mazocky.

Design applications are available to obtain patent protection where the sole distinction between the prior art is one of shape or aesthetics. Also, no convincing argument has been made that the particular shape claimed is significant or is more than one of numerous configurations a person of ordinary skill in the art would have found obvious. See *Graham v. John Deere Co.*, 148 USPQ 459 (1967) and *In re Dailey*, 149 USPQ 47 (CCPA 1976). With respect to claims 16 and 17, Mazocky discloses all structure of the claimed carton except a length of the corner post in the side panels of about 8.3 cm and, with respect to claim 17, a length into the end panel of about 8 cm. It would have been an obvious matter of design choice to make the lengths of the corner posts in Mazocky within the side and end panels of about 8.3 cm and 8 cm, respectively as a mere selection of one size over another. No functional distinction can be seen nor has any been asserted by Applicant with respect to the claimed size over the size(s) shown in Mazocky. A mere change in the size of a component has generally been held unpatentable. See *In re Rose*, 105 USPQ 237 (CCPA 1955). It is noted that the ability to size a container to hold a given size or height of content is well within the level of skill in this art. The sizing of the corner posts is considered related to the overall size of the container which is a function of size of the desired contents one wishes to package.

5. Claims 1-3, 6, 7, 13, 16, 17 and 19-21 are rejected under 35 U.S.C. 103(a) as being anticipated by Quantance. Quantance discloses a top panel 12, 160, side panels 14, 18 along two opposite sides of the carton, an end panel 14, 18 between the side panels, top panel tab 14 at the end of the carton, a first top score line between 12 and 14 at the opposite end of the carton, second top score lines 16 at the first end of the carton forming corner flaps 160 and side panel

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tabs 18 with side panel score lines 16 formed in the side panels as claimed. Quantance does not disclose a rectangular shape to the corner flaps. It would have been an obvious matter of design choice to change the form or shape of the corner flaps to a rectangular shape in Quantance as a mere selection of one shape over any other. No functional distinction is seen between the shape claimed and that shown in the prior art to Quantance. Design applications are available to obtain patent protection where the sole distinction between the prior art is one of shape or aesthetics.

Also, no convincing argument has been made that the particular shape claimed is significant or is more than one of numerous configurations a person of ordinary skill in the art would have found obvious. See *Graham v. John Deere Co.*, 148 USPQ 459 (1967) and *In re Dailey*, 149 USPQ 47 (CCPA 1976). With respect to claims 16 and 17, Quantance discloses all structure of the claimed carton except a length of the corner post in the side panels of about 8.3 cm and, with respect to claim 17, a length into the end panel of about 8 cm. It would have been an obvious matter of design choice to make the lengths of the corner posts in Quantance within the side and end panels of about 8.3 cm and 8 cm, respectively as a mere selection of one size over another. No functional distinction can be seen nor has any been asserted by Applicant with respect to the claimed size over the size(s) shown in Quantance. A mere change in the size of a component has generally been held unpatentable. See *In re Rose*, 105 USPQ 237 (CCPA 1955). It is noted that the ability to size a container to hold a given size or height of content is well within the level of skill in this art. The sizing of the corner posts is considered related to the overall size of the container which is a function of size of the desired contents one wishes to package.

6. Claims 1-7, 9, 13, 15-17 and 19-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Auclair. Auclair discloses a top panel (16, 48, triangular corner sections), two

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side panels 14, 18, top panel tab 44, first score line 50, second score lines forming the triangular corners within the top panel, side panel tabs 60, 62 attached to the remainder of the side panels along score lines 52, 54 as claimed. Auclair does not disclose a rectangular shape to the corner flaps. It would have been an obvious matter of design choice to change the form or shape of the corner flaps to a rectangular shape in Auclair as a mere selection of one shape over any other. No functional distinction is seen between the shape claimed and that shown in the prior art to Auclair. Design applications are available to obtain patent protection where the sole distinction between the prior art is one of shape or aesthetics. Also, no convincing argument has been made that the particular shape claimed is significant or is more than one of numerous configurations a person of ordinary skill in the art would have found obvious. See *Graham v. John Deere Co.*, 148 USPQ 459 (1967) and *In re Dailey*, 149 USPQ 47 (CCPA 1976). With respect to claim 15, Auclair discloses corners with a length along the respective side and end panels which is very small as compared to the overall lengths of the side and end panels. However, Auclair does not disclose a length of the corner posts along the respective side panels and the end panel of about 1 cm. It would have been an obvious matter of design choice to make the lengths of the corner posts along the respective side and end panels in Auclair about 1 cm as a mere selection of one size over another. No functional distinction can be seen nor has any been asserted by Applicant with respect to the claimed size over the size(s) shown in the prior art. A mere change in the size of a component has generally been held unpatentable. See *In re Rose*, 105 USPQ 237 (CCPA 1955). It is noted that the ability to size a container to hold a given size or height of content is well within the level of skill in this art. The sizing of the corner posts is considered related to the overall size of the container which is a function of size of the desired contents one wishes to

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package. With respect to claims 16 and 17, Auclair discloses all structure of the claimed carton except a length of the corner post in the side panels of about 8.3 cm and, with respect to claim 17, a length into the end panel of about 8 cm. It would have been an obvious matter of design choice to make the lengths of the corner posts in Auclair within the side and end panels of about 8.3 cm and 8 cm, respectively as a mere selection of one size over another. No functional distinction can be seen nor has any been asserted by Applicant with respect to the claimed size over the size(s) shown in Auclair. A mere change in the size of a component has generally been held unpatentable. See *In re Rose*, 105 USPQ 237 (CCPA 1955). It is noted that the ability to size a container to hold a given size or height of content is well within the level of skill in this art. The sizing of the corner posts is considered related to the overall size of the container which is a function of size of the desired contents one wishes to package.

7. Claims 11 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bone in view of any one of Stompe, Schmidt et al or Hunt, Jr. Bone discloses all structure of the claimed carton except a finger cut out within the top panel (cl. 11) or the removable portion (cl. 18) (Bone discloses a finger flap formed by the cut 120 which forms a finger opening when pressed inwardly). Each of Stompe, Schmidt et al and Hunt, Jr. teaches that it is known to make a finger engagement element as a cut out. It would have been obvious to make the finger engagement element in the top wall in Bone as a cut out as taught by any one of Stompe, Schmidt et al or Hunt, Jr. to allow easier engagement by the finger and to eliminate interference by the folding tab with the contents (when the tab would be pressed inwardly).

8. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Auclair in view of Holley, Jr. '435 and any one of Stompe, Schmidt et al or Hunt, Jr. Auclair discloses all

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structure of the claimed carton except finger cut outs formed in the side panel tabs. Holley, Jr. teaches that it is known to make a removable dispensing portion in a container with side panel finger engagement elements to facilitate removal of the side panel portions from the remainder of the side panels. Each of Stompe, Schmidt et al and Hunt, Jr. teaches that it is known to make finger engagement elements in a container using cut outs as opposed to openings formed by folding tabs. It would have been obvious to make the side panels in Auclair with finger engagement elements as taught by Holley, Jr. and to make the finger engagement elements as cut outs as taught by any one of Stompe, Schmidt et al or Hunt, Jr. to allow clean separation of the side portions of the removable portion during opening and since openings provide less chance of interference by the side flaps with the contents.

Allowable Subject Matter

9. Claim 8 is allowed.

Response to Arguments

10. Applicant's arguments filed 26 March 2007 have been fully considered but they are not persuasive.

The remarks assert that the provision of a rectangular shape to the top flaps is not an aesthetic difference insofar as the specification provides support for the shape and indicates that the corner posts enclose the product in the three dimensions to retain the products in the container and provide structural strength to the container for improved stackability.

In response, the shapes of the top flaps in each of the prior art references are considered to provide the same functions of increased strength and product retention. No significant functional distinction can be seen in making the top flaps rectangular as opposed to the shapes shown in the

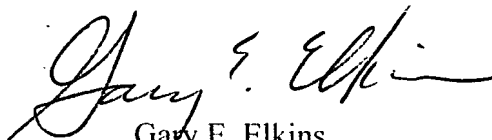
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prior art references. With respect to the functionality of the vertical corner posts, no claimed structural distinction is seen between the vertical corners and the corners shown in the prior art.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.



Gary E. Elkins
Primary Examiner
Art Unit 3782

gee
11 June 2007